

**REMARKS/ARGUMENTS**

This is in response to the Office Action dated Aug. 10th, 2006.

Claims 1-20 are cancelled, Claims 21-40 are new.

The amendments to the abstract, the specification, the drawings, and the claims are directed to corrections and the objections noted in the office action. It is believed that no new matter is introduced by the amendments.

Applicant respectfully requests entry of the amendments and withdrawal of the claim rejections.

The 35 U.S.C. §103 Rejection

Applicant traverses the rejection as it might apply to the new and amended claims for the reasons below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation in the references themselves or in knowledge generally available to one skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. And finally the prior art reference (or references when combined) must teach all claim limitations. The teaching or suggestion and reasonable expectation of success must both be found in the prior art and not in Applicant's disclosure (See MPEP §706.02(j)). Neither of the cited references or proposed combination in the office action met such criteria.

*Baldo and Maganias*

Claims 1-2, 4, 10-12, and 16-20 were rejected under 35 USC §103(a) as being unpatentable over Baldo et al. (US Pat No. 5099857) in view of Maganias et al (US Pat No. 4802493).

Applicant submits that none of the cited references and proposed combination teaches or fairly suggests the elements recited in the claims. For example, Applicant is unable to find the teaching or suggestion that the cavity of the central body has a lower end extending

beyond the horizontal plane of the sharp edge. In addition, Applicant can not find the disclosure or suggestion in Magnias or combined references of the sharp edge on the external circumference of the lower surface of the central body that is defined in the instant application. Such elements for the atopy test device are significant in ensuring better retaining of the liquid allergen. Thus, a *prima facie* case of obviousness is not established.

*Baldo, Maganias and Fishman*

Claims 3, 6, and 14 were rejected under 35 USC §103(a) as being unpatentable over Baldo et al. in view of Maganias, further in view of Fishman et al (US Pat No. 5139029).

Fisherman et al disclose a rotatable drum-like device, which is based on different principle of design. The device disclosed in Fisherman et al is difficult to apply to the skin due to lack of consistent pressure. Applicant submits that the asserted motivation concerning the proposed combination of the three references is improper, and thus, lack of a reasonable expectation of success.

*Baldo, Maganias and Zeytinoglu*

Claim 5 was rejected under 35 USC §103(a) as being unpatentable over Baldo et al. in view of Maganias, further in view of Zeytinoglu et al (US Pat No. 5874226).

Applicant submits that the asserted motivation concerning the proposed combination of the three references is improper. Zeytinoglu et al disclose a “Petri box” for testing on the skin but not inside of the skin. The instant claimed invention requires the penetration of the skin for the atopy test. There is no motivation and thus no reasonable expectation of success for one ordinary skilled in the art to transform the “Petri box” into an atopy test.

*Baldo, Maganias, Fishman, and Pitesky*

Claim 8 was rejected under 35 USC §103(a) as being unpatentable over Baldo et al. in view of Maganias, further in view of Fishman et al, further in view of Pitesky (US Pat No. 6258041).

Applicant submits that multipoint needle assembly disclosed in Pitesky is different from the instant claimed invention. The eight point needles disclosed in Pitesky's patent are on one circle instead of two circles in the instant Atopy test. The proposed combination failed to teach all the elements recited in the claimed invention.

*Baldo, Maganias, Fishman, Pitesky, and Trautman*

Claims 7 and 9 were rejected under 35 USC §103(a) as being unpatentable over Baldo et al. in view of Maganias, further in view of Fishman et al, further in view of Pitesky, even further in view of Trautman et al (US Pat No. 6083196).

Trautman et al disclose a snail crown with a small needle, and it can not be used for the atopy test of multiple compositions of antigens claimed in the instant application. Applicant submits that the asserted motivation concerning the proposed combination of the five references is improper, and thus, lack of a reasonable expectation of success.

*Baldo, Maganias, Holm, Palacios Pelaez and Vogel*

Claim 13 was rejected under 35 USC §103(a) as being unpatentable over Baldo et al. in view of Maganias, further in view of Holm et al (US Pub No. 20030175312), Palacios Pelaez et al (WO 98/59052), and Vogel et al (US Pate N. 6864404).

Applicant submits that Holm et al do not teach or suggest that PR-10 proteins are possible atopic allergens. Vogel et al disclose that pectate lyase is possible human allergens but not as atopic allergens. Thus, a *prima facie* case of obviousness is not established for the rejection.

*Baldo, Maganias, Fishman, and Lusk*

Claim 15 was rejected under 35 USC §103(a) as being unpatentable over Baldo et al. in view of Maganias, further in view of Fishman et al, even further in view of Lusk et al (US Pat No. 6423546).

Lusk et al teach that lipid transfer protein is a potential food allergen. However, there is no teaching or suggestion that this substance can be used for diagnosis of atopy.

Again, the “teaching or suggestion **and** reasonable expectation of success must be **both** be found in the prior art”. One can not simply use the applicant’s disclosure as a “blueprint” to reconstruct, by hindsight, Applicant’s claim. See, e.g., Interconnect Planning Corp. v. Feil, 227 U.S.P.Q. 543 (Fed. Cir. 1985). Applicant submits that the position taken in the Action represents impermissible hindsight of the type where “what was ‘obvious-to-try’ was to explore a superior technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.” In re O’Farrell, at 1681). This is because the general guidance provided by the above combination would not lead the skilled artisan to the diagnostic atopy kit disclosed in the instant application, in the absence of Applicant’s disclosure.

Applicant further submits that because it would not be apparent to the skilled artisan to combine various limitations of the device and the antigens for atopic testing, there is no expectation of success, and thus, no motivation to combine the cited references. Accordingly, no *prima facie* case for obviousness exists. For these reasons, Applicant respectfully requests that the rejections be withdrawn.

### CONCLUSION

Applicant respectfully submits that the pending claims are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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PATENT

Respectfully submitted,

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